

REMARKS

[0001] Claims 1, 3-5, 7-19, and 21-30 remain in the application. Claims 1, 16, 24, and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of copending Application No. 2004/0223663 in view of United States Patent No. 6,167,381 to Swaine *et al.* (hereinafter "Swaine"). Claim 3 stands rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. Claims 1, 8, 9, 16, 21, 23, 24, and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,609,223 to Iizaka *et al.* (hereinafter "Iizaka") in view of Swaine. Claims 3, 4, 7, 10, 12, 17-18, 22, 25, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iizaka and Swaine in view of U.S. Patent Number 5,497,314 issued to Novak (hereinafter "Novak"). Claims 5, 11, 19, 26, 28, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iizaka and Swaine in view of U.S. Patent Number 6,366,696 issued to Hertz (hereinafter "Hertz"). Claims 13, 14, and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Iizaka and Swaine in view of United States Patent No. 6,260,023 to Seavers (hereinafter "Seavers").

[0002] Independent claims 9, 13, 16, 24, and 27 have been amended to include the limitation of independent claim 1 as suggested by the Examiner.

RESPONSE TO REJECTIONS OF CLAIMS 1, 16, 24, AND 27 FOR DOUBLE PATENTING

[0003] The Applicants have included herewith a terminal disclaimer in response to the obvious-type double patenting rejection of Claims 1, 16, 24, and 27.

RESPONSE TO REJECTION OF CLAIM 3 UNDER 35 U.S.C. § 112

[0004] Claim 3 stands rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement.

[0005] According to the specification of the claimed invention, the "controller 210 sends the information regarding the item 102 to the confirmation module 204." *See* 14, lines 11-12. Additionally, the association module (part of the controller) "may use the coded identifier 104 as the primary search criteria," in firstly identifying the item from among the multiple candidate items

stored in the database. *See Page 13, lines 19-20.* Therefore, the confirmation module is configured to confirm with a user the identity of the item based on the coded identifier because the information the confirmation module receives from the controller may be based on the coded identifier, or alternatively based on visual characteristics of the item. The specification, therefore, does describe that the confirmation module may confirm an identity based on the coded identifier.

[0006] The Applicants respectfully assert that the rejection of claim 3 under 35 U.S.C. § 112 is improper, and therefore, the Applicants request the removal of the rejection of claim 3 under 35 U.S.C. § 112.

[0007] In response to the Examiner's comment "...it is unclear why confirmation would be necessary based on a coded identifier," the Applicants refer the Examiner to page 3, lines 12-17 which state:

A consumer may detach a bar code from an inexpensive item and affix the bar code over, or in place of, the bar code of a more expensive item. The consumer can then proceed to the checkout area and scan the item using the incorrect bar code. The pricing information is processed for a less expensive item, while the consumer leaves the store with the more expensive item. This form of theft can occur at self-checkout stations as well as regular checkout stations.

[0008] Identification based on the coded identifier, or bar code, is necessary because of the complicated steps people will go through to defraud retailers. Printable bar codes are available over the Internet using downloadable software. A person simply has to affix one of these printed bar codes over the bar code of a more expensive item and then seek out an unsuspecting cashier. This crime happens very often with expensive electronic items in smaller boxes because a cashier will believe that a small box will have a low price. If the Examiner requires further explanation, please contact the undersigned.

RESPONSE TO REJECTION OF CLAIMS 1, 8, 9, 16, 21, 23, 24, AND 27 UNDER 35 U.S.C. § 103(a)

[0009] The Examiner rejected claims 1, 8, 9, 16, 21, 23, 24, and 27 under 35 U.S.C. §103(a) as being unpatentable over Iizaka in view of Swaine.

[0010] It is well known that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See MPEP* § 2142 under the heading "ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS."

[0011] The examiner bears the initial burden of providing a motivation or suggestion to combine the references. In pertinent part, MPEP §2142 states (emphasis added), "[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must **expressly or impliedly suggest** the claimed invention or the examiner must **present a convincing line of reasoning** as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references (emphasis added)." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Applicants assert that the Office Action neither demonstrates how the references "expressly or impliedly suggest" the invention nor presents "a convincing line of reasoning" as to why the invention would be found obvious.

[0012] Iizaka teaches a checkout system with automatic registration of articles by bar code or by physical features of the article. Iizaka discloses a system that reads a bar code, decodes the bar code, derives feature data for the corresponding article from a database, and compares the feature data from the database with the feature data of the article. If there is no match in the database, the feature data of the article is registered into the database. *See* col 7, line 62 through col. 8, line 9. Unfortunately, this type of system will quickly lead to a corrupted database as unscrupulous customers will attempt to defraud a retailer by attaching bar codes belonging to cheap articles on expensive articles. The system taught by Iizaka will associate the feature data of the expensive article with the incorrect bar code and lead to greater fraud by customers. As noted by the Examiner,

Iizaka is silent towards an apparatus or method of defeating this fraud, such as the presentation module of the claimed invention.

[0013] Swaine, likewise discloses a checkout system. The system taught by Swaine includes a voice feedback device for providing audio feedback to the **customer** during the checkout procedure. An audible message is generated on the voice generating device which informs the customer of information associated with the item such as description and price. The voice generating device allows the customer to obtain information associated with each item without having to look at the display monitor. *See col 4, lines 52-65.* However, providing voice feedback to the customer does little to prevent fraud when the customer is attempting to defraud a retailer.

[0014] Conversely, the claimed invention includes the presentation module configured to provide audio information about the item. As defined in the specification of the claimed invention, audio information comprises a description of the visual characteristics of each candidate item among the plurality of candidate items presented to a user. The audio information may further include the name of each candidate item presented to a user. The presentation of audio information enables a user or cashier to listen to information regarding each candidate item of the plurality of candidate items presented by the presentation module. The presentation of audio information enables the cashier to select the proper item regardless of the bar code that a customer may have placed over a proper bar code.

[0015] The combination of Iizaka and Swaine, if possible, does not result in a system configured to defeat fraud, but rather encourages greater fraud. The voice feedback device of Swaine coupled with the database population of Iizaka would result in a database full of false feature data. For example, a customer may swap bar codes and present the item to be scanned. The voice feedback device would then describe the item based on the feature data, and then register the false feature data with wrong bar code in the database because a match is clearly not found. Such a combination, which ultimately corrupts the database and leads to greater fraud, obviously destroys the utility of both Iizaka and Swaine. Consequently, the combination of Iizaka and Swaine renders the claimed invention **nonobvious** because the Federal Circuit has determined that there is no suggestion or motivation to make a proposed modification if the modification would render the prior

art unsatisfactory for its intended purpose. *See* MPEP § 2143 under the heading **THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE.**

[0016] Furthermore, in order to establish a *prima facie* case of obviousness, the Examiner must establish a reasonable expectation of success. As described above, there would be no reasonable expectation of success because the combined Iizaka/Swaine system would perform horribly, requiring huge amounts of human intervention to repair the corrupted database every few days. Imagine a supermarket, or a home improvement center, each having inventories of 60,000+ items and attempting to discover which item has had its feature data registered improperly.

[0017] An additional factor for consideration with regard to obviousness includes the level of ordinary skill in the art at the time of invention.

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” (emphasis added) (See MPEP §2142).

[0018] Therefore, in determining motivation to combine, it is impermissible to use the specification or disclosure provided by the Applicant as a “road map” to guide one from the teachings in Iizaka to the teachings in Swaine. The Office Action merely recites elements of both Iizaka and Swaine and then states, “[a]t the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Iizaka et al. with those of Swaine et al.” If no express or implied suggestion is found, the Examiner must present a convincing line of reasoning as to why one skilled in the art at the time the invention was made would find the claimed invention obvious.

[0019] Therefore, the Applicants assert that the rejection of independent claims 1, 9, 16, 24, and 27 under 35 U.S.C. § 103(a) is improper, and the Applicants respectfully request the withdrawal of the rejection. Similarly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a) for dependent claims 8, 21, and 23 for depending from a nonobvious independent claim. *See* MPEP §2143.

RESPONSE TO REJECTION OF CLAIMS 3, 4, 7, 10, 12, 17-18, 22, 25, AND 29 UNDER 35 U.S.C. § 103(a)

[0020] The Examiner rejected claims 3, 4, 7, 10, 12, 17-18, 22, 25, and 29 as being unpatentable under 35 U.S.C. §103(a) over Iizaka/Swaine in view of Novak. Applicants respectfully submit that claims 3, 4, 7, 10, 12, 17-18, 22, and 29 are allowable for depending from nonobvious independent claims.

RESPONSE TO REJECTION OF CLAIMS 5, 11, 19, 26, 28, AND 30 UNDER 35 U.S.C. § 103(a)

[0021] The Examiner rejected claims 5, 11, 19, 26, 28, and 30 as being unpatentable under 35 U.S.C. §103(a) over Iizaka/Swaine in view of Hertz. Applicants respectfully submit that claims 5, 11, 19, 26, 28, and 30 are allowable for depending from nonobvious independent claims.

RESPONSE TO REJECTION OF CLAIMS 13, 14, AND 15 UNDER 35 U.S.C. § 103(a)

[0022] The Examiner rejected claims 13, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Iizaka/Swaine in view of Seevers.

[0023] It is well settled that the PTO has the burden to establish a *prima facie* case of obviousness. *In re Glauq*, 2002 U.S. App. Lexis 4246, *4 (Fed. Cir. March 15, 2002); MPEP §2142. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP §2143.03 (emphasis added). The Federal Circuit has

held that “the ‘subject matter’ that must have been obvious to deny patentability under §103 is the entirety of the claimed invention,” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1576 (Fed. Cir. 1987). Furthermore, even if all the claim limitations are taught or suggested, there must be some suggestion or motivation to combine reference teachings. *See* MPEP §2142. Applicant respectfully asserts that a *prima facie* case of obviousness has not been made because not all the elements recited in the claims are taught or suggested by the prior art.

[0024] Seevers teaches a system for processing transactions including a networked produce recognition system. As admitted by the Examiner, the combination of Iizaka/Swaine lacks a server. Seevers, furthermore, does not teach or disclose providing audio information for the confirmation of a product. As discussed above, the combination of Iizaka and Swaine destroys the utility of both systems, therefore rendering the combination non-workable. Applicants, therefore, respectfully assert that all of the claim limitations are not present, and furthermore there can be no motivation or suggestion to combine because the combination of Iizaka and Swaine destroys the utility of both.

[0025] Again, an important factor for consideration with regard to obviousness includes the level of ordinary skill in the art at the time of invention.

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” (emphasis added) (See MPEP §2142).

[0026] Therefore, in determining motivation to combine, it is impermissible to use the specification or disclosure provided by the Applicant as a “road map” to guide one from the teachings in Iizaka/Swaine to the teachings in Seevers. The Office Action merely recites elements of both Iizaka, Swaine, and Seevers and then states, “[a]t the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Iizaka et al./Swaine

et al. with those of Seevers et al." If no express or implied suggestion is found, the Examiner must present a convincing line of reasoning as to why one skilled in the art at the time the invention was made would find the claimed invention obvious. Merely stating that having a server is desirable is not a convincing line of reasoning. Therefore, the Office Action fails to establish a *prima facie* case of obviousness.

[0027] Applicants respectfully request the prompt withdrawal of the rejection of claims 13, 14, and 15 under 35 U.S.C. § 103(a), and assert that the claimed invention is in condition for prompt allowance.

[0028] Should additional information be required regarding the traversal of the rejections of the dependent claims enumerated above, Examiner is respectfully asked to notify Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,



Brian C. Kunzler
Reg. No. 38,527
Attorney for Applicant

Date: January 3, 2006
8 East Broadway
Suite 600
Salt Lake City, UT 84101
Telephone (801) 994-4646
Fax (801) 322-1054